UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,505	11/02/2000	William C. Hein III	60288	8087

23735   7590   04/20/2004

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EXAMINER
COLIN, CARL G

ART UNIT	PAPER NUMBER
2136	5

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/706,505	HEIN ET AL.
	Examiner	Art Unit	
	Carl Colin	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>02 November 2000</u> .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-17</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-17</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>02 November 2000</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1.   Pursuant to USC 131, claims 1-17 are presented for examination.

Specification

2.   The disclosure is objected to because of the following informalities: on page 11, line 25,

"there a number... need to assigned" should be corrected. On page 8, line 25, there is a typo

error on line 21 on the word "segments", also page 5, line 8, "his their" needs to be corrected.

Appropriate correction is required.

Claim Objections

3.   **Claim 16** is objected to for lack of indentation of limitation. See MPEP § 608.01(m).

Appropriate correction is required.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. The claims are not embodied in a computer hardware or

software.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or

described as set forth in section 102 of this title, if the differences between the subject matter

sought to be patented and the prior art are such that the subject matter as a whole would have

been obvious at the time the invention was made to a person having ordinary skill in the art to

which said subject matter pertains. Patentability shall not be negatived by the manner in which

the invention was made.

5.1   **Claims 1-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent

6,611,830 to **Shinoda et al.** in view of US Patent 6,679,420 to **Lapstun et al.**.

5.2   **As per claims 1, 6, 7, and 11**, **Shinoda et al.** discloses a method of performing identifier

registration comprising: establishing a connection with a registration process (see column 4, lines

17-46); and receiving an embedder control file, including media signal identifiers and embedder

instructions, for example (see column 5, lines 6-35). **Shinoda et al.** discloses use of

authentication, but does not explicitly disclose providing authentication (see column 7, lines 6-

16); However, **Lapstun et al.** in an analogous art teaches various ways of authentication such as

biometric data, credit card, and also discloses identification means using a business card to

convey data from the card to a computer, the card contains coded data associated with an

electronic mail address, for example (see column 3, lines 13-60 and column 37, lines 49-57).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the

invention was made to modify the method of **Shinoda et al.** to authenticate by extracting

information from a watermark embedded in an identity card and providing the extracted

information to the registration process as taught by **Lapstun et al.**. This modification would

have been obvious because one skilled in the art would have been motivated by the suggestions

provided by **Lapstun et al.** so as to interact with the computer system using a card (see column

5, lines 5-12).

As per claim 2, **Shinoda et al.** discloses sending request that includes identifier and

instruction and embedding signal files with corresponding identifiers upon request that meets the

recitation of: submitting the embedder control file to a watermark embedder, which

automatically embeds a set of media signal files with corresponding identifiers according to the

embedder instructions in the embedder control file, for example (see column 3, lines 25-50 and

column 5, lines 6-35 and column 7, lines 63-67).

As per claims 3-5, **Shinoda et al.** discloses the claimed method of claim 1 wherein the

registration process is executed at an Internet server accessible via a web interface, via an

Internet communication protocol, wherein the embedder control file is received from the

registration process via an Internet communication protocol for example (see column 1, lines 14-

30 and column 7, lines 6-16).

As per claims 8 and 10, Shinoda et al. substantially discloses a request that includes a

reference to look up a network address of the registration process in a database management

system and discloses a request that includes a network address of the registration process, for

example (see column 4, lines 56-63 and column 5, lines 49-60 and column 8, lines 23-35).

However, **Lapstun et al.** in an analogous art teaches various ways of authentication such as

biometric data, credit card, and also discloses identification means using a business card to

convey data from the card to a computer, the card contains coded data associated with an

electronic mail address. **Lapstun et al.** also discloses a reference and network address on the

physical object (see Lapstun et al. column 3, lines 54-60). Therefore, it would have been

obvious to one of ordinary skilled in the art at the time the invention was made to modify the

method of **Shinoda et al.** to provide a watermark on the physical object that includes a reference

used to look up a network address of the registration process in a database management system

or a network address of the registration process as taught by **Lapstun et al.**. This modification

would have been obvious because one skilled in the art would have been motivated by the

suggestions provided by **Lapstun et al.** so as to interact with the computer system using a card

(see column 5, lines 5-12).

As per claim 9, Shinoda et al. discloses the claimed method of claim 8 wherein the

database management system forwards information to the registration process to authenticate a

user, for example (see column 5, lines 3-12).

As per claims 12 and 15, Shinoda et al. discloses a method of performing identifier registration comprising: establishing a connection with a client process, for example (see column 4, lines 17-46); receiving authentication information from the client process to authenticate a user; receiving a registration request from the client process; allocating a set of identifiers to media signal files based on the registration request (see column 7, lines 62-67 and column 8, lines 36-63); constructing an embedder control file, including media signal identifiers and embedder instructions and sending the embedder control file to the client process, for example (see column 5, lines 6-35). Shinoda et al. discloses use of authentication, but does not explicitly disclose the steps of authentication (see column 7, lines 6-16); However, Lapstun et al. in an analogous art teaches various ways of authentication such as biometric data, credit card, and also discloses identification means using a business card to convey data from the card to a computer, the card contains coded data associated with an electronic mail address , for example (see column 3, lines 13-60 and column 37, lines 49-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Shinoda et al. to authenticate by extracting information from a watermark embedded in an identity card and providing the extracted information to the registration process as taught by Lapstun et al.. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by Lapstun et al. so as to interact with the computer system using a card (see column 5, lines 5-12).

As per claim 13, Shinoda et al. discloses the claimed method of claim 12 including: creating database records corresponding to the set of identifiers and including in the database

records media signal information associated with media signal files into which the identifiers are

to be embedded, for example (see column 4, lines 47-55).

As per claim 14, **Shinoda et al.** discloses the claimed method of claim 13 wherein the

media signal information includes a network address of a network resource associated with a

corresponding media signal, for example (see column 8, lines 36-63).

6.   **Claims 16-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent

6,611,830 to **Shinoda et al.**.

6.1   **As per claim 16**, claim 16 recites the same limitation as claim 2. **Shinoda et al.**

discloses sending request that includes identifier and instruction and embedding signal files with

corresponding identifiers upon request that meets the recitation of: submitting the embedder

control file to a watermark embedder, which automatically embeds a set of media signal files

with corresponding identifiers according to the embedder instructions in the embedder control

file, for example (see column 3, lines 25-50 and column 5, lines 6-35 and column 7, lines 63-67).

It is apparent to one skilled in the art that the invention of **Shinoda et al.** is capable of

performing the steps recited in claim 16 without departing from the spirit and the scope of the

invention.

As per claim 17, **Shinoda et al.** discloses a media signal identifier registration server

comprising: a network interface for receiving ID registration requests, the requests including a

list of media signal files and information to be linked with the media signal files via data

embedded in the media signal files, for example (see column 4, lines 17-47); discloses creating

records in a region database that meets recitation of a batch registration loader for creating

records in a registration database corresponding to identifiers for each of the media signal files,

for example (see column 4, lines 47-67 and column 7, lines 17-67); also discloses a mark

creating program for reading the database and creating embedder file, for example (see column

3, lines 25-50) that meets the recitation of and a batch registration extractor for reading the

registration database and creating an embedder control file, including identifiers, a corresponding

list of media signal files, and embedding instructions for controlling embedding of the identifiers

in the media signal files, for example (see column 4, lines 47-67 and column 7, lines 17-67). It is

apparent to one skilled in the art that the invention of **Shinoda et al.** is capable of performing the

steps recited in claim 16 without departing from the spirit and the scope of the invention.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure as the art discloses the use of card user authentication process.

US Patent: US 2001/0048025   Shinn

7.1   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Carl Colin whose telephone number is 703-305-0355. The

examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the

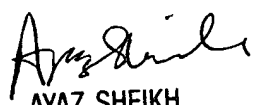organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-3900.

CC

Carl Colin

Patent Examiner

April 14, 2004

AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
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